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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,087	11/08/2000	Yuji Miyauchi	P 275329 OL9200N-US	9921

7590 02/25/2002

Pillsbury Winthrop LLP  
Intellectual Property Group  
1600 Tysons Boulevard  
McLean, VA 22102

EXAMINER

SPECTOR, DAVID N

ART UNIT	PAPER NUMBER
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2873

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DATE MAILED: 02/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/708,087

Applicant(s)

MIYAUCHI, YUJI

Examiner

David N. Spector

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on November 8, 2000 through July 27, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☒ Claim(s) 32-33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on November 8, 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☒ Other: DETAILED ACTION.

**NON-FINAL REJECTION*****Claim Objections - 37 CFR 1.75(c)***

1. Claim 32 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. In particular claim 32 recites "the zoom lens system according to any one of claims 1 to 8, 18, 23 and 25-31, [and] which further satisfies the following condition:  $2.5 \text{ mm} < f_{B(\text{max})} < 4.8 \text{ mm}$ ". Here, however, each of claims 1-8, 18 and 25-29 already expressly recites the aforesaid conditional relationship. Claims 32/30 and 32/31 being excepted, applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

***Claim Rejections - 35 U.S.C. 101***

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

3. Claims 1-21 of the instant application are rejected under 35 U.S.C. 101 as claiming the same inventions as claims 10-30, respectively, of prior U.S. Patent No. 6,331,917 B1 (e.g. '917). The exact wording of instant claims 1-21 varies slightly from that of claims 10-30 of '917 where applicant has substituted a variety of inconsequential synonyms into the instant claims. Said variations are purely semantic, however, inasmuch as their use in said instant claims does not represent any change in the features/limitations recited therein relative to the aforesaid '917 claims (e.g. the features/limitations are physically identical). This is a statutory double patenting rejection.

4. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome only by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

### ***Claim Rejections – Nonstatutory Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

6. Claims 22-30 and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 31-39 and 37 (respectively) of U.S. Patent No. 6,331,917 B1 (e.g. '917). Although the conflicting claims are not identical, they are not patentably distinct from each other because the term "cemented lens" recited repeatedly in claims 22-30 and 31 admits a broader range of actual interpretations (e.g. a cemented doublet; a cemented triplet; etc.) than does the term "doublet" as used in claims 31-39 and 37 of the '917 patent (e.g. air-spaced, cemented, etc.). On the other hand, the functional equivalence of said doublet and/or said cemented lens would have been widely known, and would thus be obvious, to one of ordinary skill in the art at the time of the instant invention.

7. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a regis-

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tered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

***Allowable Subject Matter***

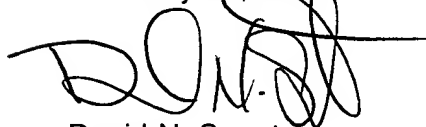
8. Claims 33, 32/<sub>30</sub>, 32/<sub>31</sub> are objected to as being dependent upon a rejected base claim, but could be made allowable under the terminal disclaimer noted above, if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**REMARKS**

9. Applicant is invited to contact the examiner for a more detailed discussion of the allowable subject matter indicated above, if it would appear to be useful in the formulation of a response to this Office action

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David N. Spector whose telephone number is (703) 305-1521. The examiner can normally be reached at this number Monday through Friday between 6:00 AM and 2:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps, can be reached on (703) 308-4883. The fax number for the organization where this application is assigned is (703) 308-7722.

February 21, 2002



David N. Spector  
Patent Examiner



Georgia Epps  
Supervisory Patent Examiner  
Technology Center 2800